

In response, the applicants elect claims 35-50, identified as group I, for prosecution on the merits. This election is made with traverse. Additionally, although the applicants believe that the examiner's requirement for an election of species is improper and will address it in detail below, the applicants elect claims 36 and 40, with traverse.

First, the applicants disagree with the examiner's assertion that the claims of groups I and II and I and III are subcombinations disclosed as useable together. As described in MPEP § 806.05, a combination/subcombination requires that two discernible elements or feature sets, described in the MPEP as "A" and "B," be present in the claims. The applicants cannot discern from the examiner's comments which features the examiner believes to constitute the subcombinations that are allegedly present in the groups of claims. Moreover, if the examiner insists that the claims of groups I and II and I and III are subcombinations useable together, which the applicants do not concede, then the applicants submit that they should be analyzed according to the situation set forth in MPEP § 806.05(c)(II) ( $AB_{sp}/B_{sp}$ ), in which case restriction is improper even if separate utility can be shown.

Furthermore, the applicants respectfully submit that the examiner's reasons for insisting on restriction, particularly between groups I and II, are insufficient. MPEP § 806.05(c) specifically states that "to support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary," (emphasis added). Therefore, even if, *arguendo*, the claims are distinct, the examiner must show that there are reasons for insisting on restriction. According to MPEP § 808.02, three such reasons exist for insisting on restriction: (A) separate classification, (B) separate status in the art when they are classified together, or (C) separate field of search.

Of those possible reasons for insisting on restriction, the examiner has admitted that groups I and II are classified together, has not identified a separate field of search for groups I

and II, and does not explain why the claims of groups I and II are believed to constitute “recognized divergent subject matter.” With respect to the issue of “divergent subject matter,” the examiner has only set forth an example of how the methods of claims 35 and 51 allegedly might be used separately, not why those methods would constitute divergent subject matter. In fact, the examiner’s claim of “divergent subject matter” appears to the applicants to be nothing more than a naked assertion. The applicants note that MPEP § 808 admonishes that “reasons” are distinguished from “mere statements of conclusion.”

Moreover, the applicants fail to understand how searching for the subject matter of claims 35-50 and 51-56 could possibly be a burden on the examiner, because the examiner admits that the claims are classified in the same class and subclass and has not identified a separate field of search. The applicants also believe that the subject matter of groups I and III is sufficiently related such that a search for the subject matter of one group would necessarily involve a search for the subject matter of the other. MPEP § 803 states that “if the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.”


The applicants also submit that the election of species required by the examiner is improperly made. An election of species should be made on the basis of subject matter and, therefore, the applicants should be given the opportunity to identify those claims which read on elected subject matter. MPEP § 806.04(e) specifically states that “*claims are never species*” (emphasis in original). As the requirement currently stands, the examiner has not identified the subject matter alleged to constitute distinct species, and the applicants have not been given an opportunity to determine which claims read on that subject matter. Additionally, the applicants believe that the election of species requirement is confusing, in

that the applicants are unsure as to which claims will be under examination if the requirement is made final. For example, does the examiner intend to consider claims 41-45 on the merits?

In view of the foregoing, the applicants respectfully request that this restriction requirement be withdrawn and that all claims be examined on the merits.

As a final note, the applicants are disappointed that the examiner chose not to use the U.S.P.T.O.-encouraged telephone restriction procedures, which might have expedited this matter and avoided some of the issues that the applicants have noted above. Should any questions arise, the examiner is encouraged to contact the undersigned to discuss those questions.

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